



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/527,138 | 03/16/2000 | Wolfgang Thiel | P00.0173 | 1989 |

7590 07/30/2002

SCHIFF HARDIN & WAITE
Patent Department
6600 Sears Tower
Chicago, IL 60606-6473

EXAMINER

WOO, RICHARD SUKYOON

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3629

DATE MAILED: 07/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/527,138

Applicant(s)

THIEL, WOLFGANG

Examiner

Richard Woo

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Information Disclosure Statement

1) The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

2) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3) Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, line 6, the recitations of "said additional data" and "said manufacturing location" lack antecedent basis.

In Claim 2, line 4, the recitation of "said use location" lacks antecedent basis.

In Claim 3, lines 2 and 6, the recitations of "said non-interchangeable memory" render the claim indefinite because not only they lack antecedent basis, but also it is not clear whether the memory is not interchangeable physically or the data is not interchangeable.

Claim Rejections - 35 USC § 102

4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5) Claims 1-2, 7 and 9, as far as they are definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Vanpoucke (US 5,262,939).

Vanpoucke discloses a method for entering contents of a franking imprint into a postage meter machine,

wherein the postage meter machine has: a printer (10-13); a microprocessor (3) connected to the reader; a NVM (2) connected to the microprocessor, the NVM containing memory areas for storing data for producing franking imprint; the microprocessor receiving data from the chip card reader from a chip card,

the method comprising the steps of:

storing a set of data in a NVM (2) of the postage meter machine by programming the data at a manufacturing location (the data being country-specific data or different carrier-specific data);

installing a data communication interface (20);

configuring the franking imprint dependent on at least one of a selected carrier and a selected country;

installing a chip card reader as the interface, configuring the postage meter machine using a chip card (20) insertable into the reader before delivery of the machine to a use location; and

wherein the interface comprises a chip card reader, including the additional step of transferring print image data for franking imprint from a chip card (20) inserted in the chip card reader into a graphic memory of the machine.

6) Claims 1-9, as far as they are definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Freytag (US 5,490,077).

Freytag discloses a method for entering contents of a franking imprint into a postage meter machine,

wherein the postage meter machine has: a printer; a microprocessor (5) connected to the reader; a NVM (3) connected to the microprocessor, the NVM containing memory areas for storing data for producing franking imprint; the microprocessor receiving data from the chip card reader from a chip card (10, 13),

the method comprising the steps of:

storing a set of data in a NVM (3) of the postage meter machine by programming the data at a manufacturing location (the data being country-specific data or different carrier-specific data);

installing a data communication interface (10, 13);

configuring the franking imprint dependent on at least one of a selected carrier and a selected country;

installing a chip card reader as the interface, configuring the postage meter machine using a chip card (10, 13) insertable into the reader before delivery of the machine to a use location;

storing the additional data in the NVM in a non-erasable manner at the manufacturing location, selecting from a plurality of different carrier-specific data by communicating the interface with a country-specific chip card (10) inserted into the reader, setting an inhibit bit in the NVM after removing the chip card;

wherein the additional data includes carrier-specific data and country-specific data, both a carrier-specific selection and country-specific selection are made using the chip card (10, 13);

wherein the interface comprises a chip card reader, comprising configuring the postage meter machine at the manufacturing location for a selected country wherein the postage meter machine is to be used by inserting a country-specific chip card (10) into the reader and combining country-specific data on the chip card with the permanently stored carrier-specific data;

wherein the interface comprises a chip card reader, comprising configuring the postage meter machine at the manufacturing location for a selected country wherein the postage meter machine is to be used by inserting a carrier-specific chip card (13) into the reader and combining carrier-specific data on the chip card with the permanently stored country-specific data;

wherein the interface comprises a chip card reader, including the additional step of transferring print image data for franking imprint from a chip card inserted in the chip card reader into a graphic memory of the machine; and

wherein the interface comprises a chip card reader, comprising configuring the postage meter machine at the manufacturing location for a selected country wherein the postage meter machine is to be used by inserting a country-specific chip card (10) into the reader and combining country-specific data on the chip card with the permanently stored country-specific data.

7) Claims 1-9, as far as they are definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Märkl et al. (US 5,710,706).

Märkl et al. discloses a method for entering contents of a franking imprint into a postage meter machine,

wherein the postage meter machine has: a printer; a microprocessor (5) connected to the reader; a NVM (3) connected to the microprocessor, the NVM containing memory areas for storing data for producing franking imprint; the microprocessor receiving data from the chip card reader from a chip card (10), the method comprising the steps of:

storing a set of data in a NVM (3) of the postage meter machine by programming the data at a manufacturing location (the data being country-specific data or different carrier-specific data);

installing a data communication interface (10);

configuring the franking imprint dependent on at least one of a selected carrier and a selected country;

installing a chip card reader as the interface, configuring the postage meter machine using a chip card (10) insertable into the reader before delivery of the machine to a use location;

storing the additional data in the NVM in a non-erasable manner at the manufacturing location, selecting from a plurality of different carrier-specific data by communicating the interface with a country-specific chip card (10) inserted into the reader, setting an inhibit bit in the NVM after removing the chip card;

wherein the additional data includes carrier-specific data and country-specific data, both a carrier-specific selection and country-specific selection are made using the chip card (10);

wherein the interface comprises a chip card reader, comprising configuring the postage meter machine at the manufacturing location for a selected country wherein the postage meter machine is to be used by inserting a country-specific chip card (10) into the reader and combining country-specific data on the chip card with the permanently stored carrier-specific data;

wherein the interface comprises a chip card reader, comprising configuring the postage meter machine at the manufacturing location for a selected country wherein the postage meter machine is to be used by inserting a carrier-specific chip card (10) into the reader and combining carrier-specific data on the chip card with the permanently stored country-specific data;

wherein the interface comprises a chip card reader, including the additional step of transferring print image data for franking imprint from a chip card inserted in the chip card reader into a graphic memory of the machine; and

wherein the interface comprises a chip card reader, comprising configuring the postage meter machine at the manufacturing location for a selected country wherein the postage meter machine is to be used by inserting a country-specific chip card (10) into the reader and combining country-specific data on the chip card with the permanently stored country-specific data.

8) Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Wright et al. (US 4,802,218, US 4,900,903 or US 4,900,904).

Wright et al. discloses an arrangement comprising:

a chip card reader (11);

a microprocessor (30) connected to the reader;

a NVM (43) connected to the microprocessor, the NVM containing memory areas for storing data for producing franking imprint;

the microprocessor receiving data from the chip card reader from a chip card (10).

9) Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Guenther (US 6,111,951).

Guenther discloses an arrangement comprising:

a chip card reader;

a microprocessor (91) connected to the reader;

a NVM (94) connected to the microprocessor, the NVM containing memory areas for storing data for producing franking imprint;

the microprocessor receiving data from the chip card reader from a chip card (70).

10) Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Guenther et al. (US 5,852,813).

Guenther discloses an arrangement comprising:

a chip card reader (20);

a microprocessor (6) connected to the reader;

a NVM (5a) connected to the microprocessor, the NVM containing memory areas for storing data for producing franking imprint;

the microprocessor receiving data from the chip card reader from a chip card.

Conclusion

11) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 3629

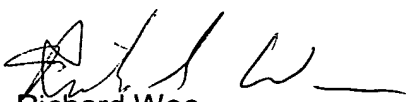
Kelly et al. is cited to show a multi-currency postage meter.

Ratzenberger, Jr. et al. is cited to show a postage meter system having separable modules with multiple currency capability.

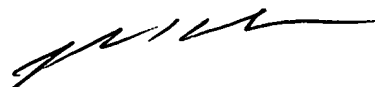
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
July 24, 2002



JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600